

REMARKS

Claims 6-10 are pending; no claims are amended in this Response.

1. No Reasons Given for Additional Search and Withdrawal of Allowance

In the Office Action dated January 7, 2005, the Patent Office states: “the Examiner has made an updated search and found new prior art.” In light of the fact that claims 6-10 previously were allowed, Applicants respectfully request additional explanation. According to the MPEP,¹ a claim “noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. Great care should be exercised in authorizing such a rejection.” (Emphasis added.) The Office Action provides no assurance to Applicants that the above-noted requirements have been complied with. Applicants are told only that the Examiner decided to go back (after the claims had been allowed) and look for more prior art.² No reason is given for the decision to perform that after-allowance search. Applicants therefore respectfully ask what that reason was.

2. “New” Art Has Been Available for Years

Although the Office Action asserts that “new prior art” was found, the only newly-cited reference is Lemon (U.S. Pat. No. 4,764,041), which issued in 1987, and thus has been available as prior art since well before this application was filed. Applicants therefore respectfully submit that Lemon could have been cited much earlier in this case, and respectfully note that piecemeal examination of applications “should be avoided as much as possible.” See MPEP § 707.07(g).

3. “New” Art Not Close Enough to Justify Withdrawal of Allowance

As explained below, the “new prior art” is not very good. It is non-analogous, it doesn’t teach anything related to the claimed invention or related to Levergood, there is no suggestion in the prior art to combine it with Levergood, and it cannot properly be combined

¹ See MPEP § 706.04.

² Applicants appreciate the expression of regret made by the Examiner.

with Levergood to render claim 6 obvious. “Lemon” is aptly named, and finding such a below-par reference is hardly sufficient justification for withdrawing the statement of allowance of claims 6-10 (even if another search had been called for).

4. All Claim Rejections Traversed

The claim rejections based on Levergood and Lemon are respectfully traversed, for at least the following reasons.

A. Lemon is non-analogous art.

Applicants’ field of endeavor in this case is “detecting fraudulent activity related to web-based, click-based promotions.” The Patent Office may disagree, but regardless of how broadly Applicants’ field of endeavor is characterized, it clearly has nothing to do with paper coupons or identifying fraudulent use thereof.

Lemon was filed in 1983 - many years before commerce on the Internet existed - and Lemon has no teachings that relate in any way to the Internet. Detecting fraudulent paper coupon activity, as taught by Lemon, is based on tracking coupons via point-of-sale encoding printed on the paper coupons – see Lemon at column 1, line 55 - column 2, line 38. Lemon says nothing about the Internet, electronic coupons, or Internet promotions, and suggests no method that could be modified (by Levergood, for example) for use in detecting fraudulent Internet activity.

Thus, Lemon is totally unrelated to Applicants’ field of endeavor, and also is totally unrelated to the particular problem with which Applicants’ invention was concerned. As a consequence, Lemon is non-analogous art.³ See MPEP § 2141.01(a).

If the Patent Office disagrees and continues to rely upon Lemon, Applicants respectfully request identification of: (a) what the Patent Office believes to be the field of Applicants’ endeavor, and (b) the particular problem with which the Patent Office believes Applicants’ invention is concerned.

B. No suggestion to combine Lemon and Levergood.

There is no suggestion in Levergood that it should be combined with Lemon, and no suggestion in Lemon that it should be combined with Levergood. Moreover, one skilled in the art at the time of Applicants' invention wishing to track fraudulent activity related to Internet promotions would not consider combining the teachings of Levergood (which, as explained in prior responses, relates to a method for controlling and monitoring access to network servers, and has nothing to do with Internet commerce related promotions or detecting fraudulent activity related thereto) with the teachings of Lemon (which, as explained above, relates only to printing certain information on paper coupons at point-of-sale). The only apparent reason the Patent Office could have for trying to combine these two disparate references is to try to invalidate claim 6. But the impropriety of using an applicant's claims as a roadmap and motivation for combining references is well-known.

C. Combination of Lemon and Levergood would change principle of operation of either.

Combining Levergood and Lemon does not seem to result in anything operable, or even discernible. Moreover, a proposed modification cannot change the principle of operation of a reference or render the prior art unsatisfactory for its intended purpose. See MPEP § 2143.02. Applicants fail to discern how Lemon could reasonably be modified by Levergood without changing Lemon's principle of operation, or vice versa. The Office Action asserts (on page 4) that "the limitation . . . taught by Lemon" could be used to modify "the internet server of Levergood" to "control the number of coupons or promotions issued an[d]/or redeemed." Applicants do not see how printing codes on paper coupons at point-of-sale could be used in Levergood's servers to do anything at all, let alone detect the fraudulent activity to which claim 6 is directed. Clarification is respectfully requested.

D. Combination of Lemon and Levergood does not result in claimed invention.

³ Levergood also is non-analogous art, and Applicants reserve the right to make that argument if it becomes necessary.

Even if the teachings of Lemon and Levergood could be combined in some reasonable manner, that combination would not result in the invention claimed in claim 6. For example, claim 6 requires a clearinghouse server. Levergood discloses no clearinghouse server. The Office Action asserts that Levergood teaches a clearinghouse server at column 5, lines 17-41, but those lines discuss only typical Internet servers. No mention is made of a clearinghouse server, or of any server that reasonably could be construed to be a clearinghouse server. As explained in the subject specification, a clearinghouse server is “programmed to track, manage, and audit associated transactions of [u]sers clicking-through [a] [c]ontent [p]rovider web site and purchasing a product or service from a [m]erchant.” Merely referring to generic servers, as Levergood does, is not teaching clearinghouse servers. Neither Levergood nor Lemon teaches a clearinghouse server, and their combination does not teach a clearinghouse server. Consequently, those two references cannot be combined to render claim 6 unpatentable.

But “clearinghouse server” is only one example of claim 6 limitations missing from both Lemon and Levergood. Levergood and Lemon, even when improperly combined, also fail to teach detecting fraudulent activity related to Internet promotions. As explained above, the teachings of Lemon are not applicable to detecting fraudulent activity on the Internet, and Levergood says nothing about Internet promotions or detecting fraudulent activity related thereto.

E. No *prima facie* case of obviousness has been established.

Even if the (improper) combination of Levergood and Lemon disclosed both a clearinghouse server and a method of detecting fraudulent Internet activity related to promotions, that would still not suffice to render claim 6 unpatentable. To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. For example, claim 6 requires content providers with web pages that “include linking instructions associated with select promotions” and “a Clearinghouse server for automatically tracking [user] interactions with said promotions, said Clearinghouse server further comprising programming for detecting fraudulent activity relating to said promotions.” Thus, in order to have any hope of rendering claim 6 unpatentable, the Patent Office must, at a minimum, find one or more references that alone or in combination teach: (a) web pages with linking instructions associated with select promotions; and (b) a clearinghouse server programmed to

detect fraudulent activity relating to those promotions. Neither of those limitations is even remotely suggested by Levergood and/or Lemon. Consequently, the Patent Office has not presented a *prima facie* case of obviousness of claim 6, and the § 103 rejection of that claim should be withdrawn.

F. No grounds provided for rejecting claims 7-10.


The Office Action provides no grounds whatsoever for rejecting claims 7-10. No assertion is made that Levergood or Lemon discloses any of the additional limitations present in claims 7-10 (for example, claim 7 has the additional limitation of fraud detection programming with click pattern assessment over time). Thus, the rejections of claims 7-10 are improper on their face, and should be withdrawn.

All pending claims are believed to be allowable, and prompt notification of (re-) allowability will be appreciated.

No fee (other than the one-month extension fee authorized above) is believed due with this Response. However, if any fee is due, please charge that fee to Deposit Account No. 50-0310.

Respectfully submitted,

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